REMARKS

Claims 1-37 were pending. Claims 1, 32, 35, 36 and 37 are amended. No Claims are canceled. Claims 38-44 have been added. Accordingly claims 1-44 will be pending upon entry of the above amendment.

Claim 36 was objected to because of an ungrammatical informality. Claim 36 has been amended to correct this informality.

Claims 1-35 and 37 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, and under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Claims 1-35 and 37 have been amended so as to comply with the written description requirement and to correct indefiniteness.

Claims 1, 2, 4, 8, 9-12, and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,313,835 issued to Gever et al., in view of U.S. Patent No. 6,308,206 issued to Singh and in view of U.S. Patent No. 6,490,601 issued to Markus et al.

Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gever et al. '835, Singh '206, and Markus et al. '601, and further in view of U.S. Patent No. 6,009,410 issued to LeMole et al. Claims 5 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gever et al. '835, Singh '206, and Markus et al. '601, and further in view of the article "Macromedia Flash Animation now Native in RealSystem 5.0." Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gever et al. '835, Singh '206, Markus et al. '601, the article "Macromedia Flash Animation now

Native in RealSystem 5.0," and further in view of U.S. Patent No. 6,182,125 issued to Borella et al.

Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gever et al. '835, Singh '206, and Markus et al. '601, and further in view of U.S. Patent No. 6,453,300 issued to Simpson. Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gever et al. '835, Singh '206, and Markus et al. '601, and further in view of U.S. Patent No. 5,822,524 issued to Chen. Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gever et al. '835, Singh '206, and Markus et al. '601, and further in view of the article "Working on Site." Claim 17 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gever et al. '835, Singh '206, and Markus et al. '601, the article "Working on Site," and further in view of official notice.

Claims 18, 19, 21, 24, and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gever et al. '835, Singh '206, and Markus et al. '601, the article "Working on Site," official notice, and further in view of U.S. Patent Application No. 2002/0070834 published by Kaufmann et al.

Claim 22 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gever et al. '835, Singh '206, and Markus et al. '601, and further in view of U.S. Patent No. 6,904,408 issued to McCarthy et al. Claim 23 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gever et al. '835, Singh '206, and Markus et al. '601, and further in view of official notice. Claim 27 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gever et al. '835, Singh '206, and Markus et al. '601, and further in view of U.S. Patent No. 6,442,529 issued to Krishan et al.

Claims 28-31 were rejected under 35 U.S.C. § 103(a) as being

unpatentable over Gever et al. '835, Singh '206, and Markus et al. '601, and further in view of official notice. Claim 32 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gever et al. '835, Singh '206, and Markus et al. '601. Claim 33 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gever et al. '835, Singh '206, and Markus et al. '601, and further in view of U.S. Patent No. 6,084,628 issued to Sawyer. Claim 34 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gever et al. '835, Singh '206, and Markus et al. '601, and further in view of the publication by Kaufmann et al. '084.

Claim 35 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gever et al. '835, Singh '206, and Markus et al. '601, the article "Macromedia Flash Animation now Native in RealSystem 5.0," Simpson '300, McCarthy et al. '408, LeMole et al. '410, the article "RedEye Recruitment: RedEye Recruitment to Push Growing Industry Demand for Accountable Online Advertising Tracking," Krishan et al. '529, the article "Sony goes to the Net via Visa," and further in view of U.S. Patent No. 6,182,125 issued to Bordella et al.

Claim 36 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gever et al. '835, Singh '206, and Markus et al. '601.

Claim 37 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gever et al. '835, Singh '206, and Markus et al. '601, the article "Macromedia Flash Animation now Native in RealSystem 5.0," Simpson '300, McCarthy et al. '408, LeMole et al. '410, the article "RedEye Recruitment: RedEye Recruitment to Push Growing Industry Demand for Accountable Online Advertising Tracking," Krishan et al. '529, the article "Sony goes to the Net via Visa," and further in view of U.S. Patent No. 6,182,125 issued to Bordella et al.

The previously pending independent claims were claims 1, 32, 35, 36, and 37. The Applicants note that each of the above rejections was based on, *inter alia*, three primary patent references: Gever et al. '835, Singh '206, and Markus et al. '601.

Examiner Interview

Applicants thank the examiner for the telephone interview on September 21, 2006. Among other things, applicant's representative described certain features of the amended and new claims below, including the "dynamic" nature of the applicants' embedded advertisement placeholder, how the placeholder is in a fixed positional relationship to a moving character, how the placeholder remains dynamically contained in a multimedia presentation, and how the present invention differs from Gever and Markus. The examiner also noted that the new power of attorney needs to be executed by the remaining inventors. No agreement was reached.

The Claimed Invention

Within the current claims, as amended, applicants use the term *"multimedia presentation"* to refer to digital entertainment content such as computer animated cartoons, feature films, and television series episodes, or movies containing CGI (computer-generated imagery) effects. In addition to being comprised of computer graphics and/or full-motion video, a computer animated cartoon, movie, or TV series episode has a plot or storyline that is presented. The present invention is targeted at insertion of embedded advertisements that play a dynamic role within the plot or storyline of the animated content. In contrast to "banner ads" that are displayed alongside web page contents or standalone advertisements that are inserted within streaming

video or audio files, these embedded advertisements exist within the storyline and the semantic content of the multimedia presentation.

The term "*embedded advertisement placeholder*" is used in the current claims, as amended, to refer to the entity that stands within the multimedia presentation in place of an embedded advertisement until such time as the final entertainment product is dynamically produced and presented. The exact form of this embedded advertisement placeholder varies somewhat depending upon the form of multimedia content that is being produced. In the present context, the term "embedded advertisement placeholder" refers to the entity which stands in place of an object within a computer animated cartoon, movie, or TV series episode and is subsequently replaced by a particular instance of the object, the intent of which is to advertise a specific product or service. Hence, the term is intended to convey that not only is a *placeholder* embedded within an animation code sequence, but also an *advertisement* is being embedded within the plot or storyline (i.e., the semantic content) of the cartoon, movie, or TV episode.

Gever et al. (US6313835)

Independent claims 1, 32, and 35-37 stand rejected under 35 U.S.C. §103(a). Accordingly, independent claims 1, 32, and 35-37 have been amended to more explicitly claim an embedded placeholder programmed to "***dynamically follow***" a series of actions of a given item within a multimedia presentation. Support for these amendments may found in the original specification at, for example, page 3, lines 4-5 and page 8, lines 7-9.

The Examiner argues that Gever "***implies*** an embedded placeholder, to hold a place for such alternative pictures or animations as a background which

changes with the time or season." Also, the Examiner notes that "even if Gever's invention could somehow be implemented . . . without anything qualifying as an embedded placeholder, the use of embedded placeholders is well known, as taught by Singh. The Examiner further argues that it would have been obvious "to use an embedded placeholder as recited, for the obvious advantage of readily presenting whatever advertisements."

Applicants agree with the Examiner that Gever ***implies*** the use of alternative pictures or animations as a background which can change. In addition, Applicants further agree with the Examiner that Gever apparently does ***not disclose*** the use of an embedded placeholder.

It is seen that Gever teaches inserting various web page components (such as animation sequences) into a web page (Abstract), wherein the user may be able to change various attributes of animation sequences such as colors, texts, fonts, characters, borders, sounds, embedded pictures, and models (col. 2, lines 9-21). Gever also teaches conditional characters that may be used in animation sequences, wherein a character actually displayed in place of a conditional character may be chosen based on data pertaining to the web page visitor (col. 2, lines 29-36). Additionally, Gever teaches the insertion of data or images into animation sequences (col. 3, lines 35-40). Gever even teaches the preparation of a Web page based on the selection of a category that can include advertisements (col. 8, lines 6-10).

However, Gever fails to apparently teach or suggest an "embedded advertisement placeholder" as set forth in all of the independent claims, as now amended. As suggested by the Examiner, Gever makes it far from clear that it discloses an embedded placeholder, let alone one that is an "embedded advertisement placeholder" as now claimed. In the present invention, it can be

seen that the "embedded advertisement placeholder" is not simply a part of the background that is subject to change, as in Gever and pointed out by the Examiner. Rather, it is a *dynamic* object that is fully integrated within the storyline or semantic content of a computer animated cartoon, movie, or television series episode.

Additionally, Gever apparently fails to disclose or suggest an embedded advertisement placeholder that will "*dynamically perform*" or "*dynamically follow*" the actions of a given item, as set for independent claims 1, 32, 35, 36, 37 and 38. While Gever may teach the insertion of an image in an animation sequence or the insertion of an advertisement in a web page, there seems to be no teaching or disclosure of an "embedded advertisement placeholder" that follows the actions of an item in the web page, let alone one that can "*dynamically follow*" the actions of an item within a computer animated cartoon, movie, or TV series episode, as in the present invention.

Similarly, Gever fails to disclose or suggest an embedded advertisement placeholder that "remains dynamically contained" in a multimedia presentation, as in new independent claim 41.

Nor does Gever disclose or suggest an embedded advertisement placeholder "remaining in a fixed positional relationship" to a character that moves in a "series of actions" in the animation, as set forth in new independent claim 38. Again, even assuming that Gever teaches an embedded placeholder, there is no apparent teaching or disclosure of a positional relationship of the placeholder to a character or a character involved in a "series of actions."

Furthermore, Gever fails to disclose or suggest an object that includes "an embedded advertisement placeholder that remains dynamically contained"

in the multimedia presentation and wherein the object is "distinct from a general background" of the multimedia presentation, as set forth in new independent claim 41. Here again, while Gever would have to be stretched in interpretation to include an embedded advertisement placeholder, it would be one that is merely in the "background" as suggested by the Examiner, and not "distinct from a general background" as in the present invention.

Yet another failing by Gever is that it is apparently dependent on the user to select and change attributes. Gever provides a "plurality of basic animation sequences having variable attributes associated therewith, responsive to **_selection_** of the sequence **_by a remote user_**, and which allows the remote user to change one or more of the variable attributes of the selected sequence (col. 6, lines 4-12). Thus, Gever seems to fail to disclose or teach the elimination of a remote user to operate the system, as in the present invention. In particular, Gever fails to show at least the following automated features of the present invention:

 1. "selector means for selecting a relevant advertisement"

 2. "inserter means for inserting the relevant advertisement stored separate from the multimedia presentation into the embedded advertisement placeholder."

Accordingly, neither Gever alone nor in combination with the below references discloses or makes obvious the present invention as now claimed.

<u>Singh (US6308206)</u>

The Examiner argues that Singh '206 shows that the use of "embedded placeholders" is well known, and relies on col. 3, lines 50-63 for such argument.

In contrast to Gever, which discloses how to make web pages, Singh discloses a script program that retrieves information, parses a template document, retrieves embedded object identifiers, retrieves the value of a requested attribute, may convert the value to a meaningful form, and replaces the embedded placeholder with this value (col. 3, lines 49-55).

While Singh may use the phrase "embedded placeholder", applicants respectfully disagree that this teaches or suggests an "embedded advertisement placeholder" of the present invention. The replacement of an embedded placeholder with a value, i.e., the holding of place in a template form for data to be later filled in as in Singh, is quite different from an "embedded advertisement placeholder" of the present invention.

Among other things, Singh does not teach or disclose that the embedded placeholder can be used for "advertising", as in the present independent claims. Singh appears to only disclose the computer system management – without any apparent teaching of how this might apply to Internet advertising of the present invention.

Next, Singh fails in disclosing or showing an embedded placeholder (whether for advertising or not) that will "dynamically follow" a part of a multimedia presentation such as a computer animated cartoon, movie, or television series episode. Broadly interpreted, Singh does use the term "embedded placeholder" to represent a **_static_** characteristic of a system of computers and network devices, but not a **_dynamic_** object within a computer-generated animation as in the present invention.

Furthermore, even though Singh uses the term "embedded placeholder", Singh fails to show or disclose the use of such a placeholder "remaining in a

fixed positional relationship" to a character that moves in a series of actions, as in new independent claim 41. Nor does Singh teach or suggest an embedded placeholder "remaining in a fixed positional relationship" to a character that moves in a "series of actions" as in new independent claim 38.

Thus, Singh, neither alone nor in combination with the other references of record, discloses or renders obvious the present invention as now claimed.

Markus et al. (US6490601)

The Examiner argues that Markus (col. 1, line 66 to col. 2 line 37) shows that it is well known that advertisements can be stored separately from a website. It is also argued by the Examiner that Markus teaches delivering to the user an ad created by the inserter means from the website and the set of ads stored separately.

To the contrary, applicants note that Markus specifically states that "[m]any Internet web pages are composite pages, requiring information in the form of images, text, and/or code to be pulled from several different remote Internet resources" (col. 2, lines 1-4). Thus, Markus teaches web pages that may take components (including advertisements) from a variety of different sources.

However, the present invention is not merely based on being able to obtain information from different sources. Rather, the present invention does include "inserting the relevant advertisement stored separate from the multimedia presentation into the embedded advertisement placeholder of the multimedia presentation" as in independent claims 1, 32, 35, 36, and 37 as now amended, and which Markus fails to disclose or suggest. In that regard, Markus

does not show or teach a placeholder that "dynamically follows" the actions of an object within a multimedia presentation, as in the independent claims as now amended. Moreover, there is a distinction between a web page containing multiple text, image, or video components, some of which may be advertisements, and the present invention having a computer animated cartoon, movie, or TV series episode that is generated to contain advertisements embedded within the storyline or semantic content of the presentation.

Accordingly, Markus neither discloses nor makes obvious the present invention, either alone or in combination with the other references of record.

Dependent Claims

It can be seen that the rejected dependent claims all depend upon the above discussed independent claims. As the above independent claims, as now amended, better describe the present invention over the cited references, all rejections of the dependent claims should be moot.

Other References of Record

While the remarks have not addressed all references cited by the Examiner or all points raised by the Examiner, the omission by applicants in addressing those items is not to be considered an acknowledgement of the correctness of the Examiner's position or a waiver of applicant's position. Instead, applicant has chosen to address the primary issues raised by the Examiner in an attempt to simplify and expedite prosecution.

CONCLUSION

For the above reasons, Applicants respectfully request reconsideration and withdrawal of the rejection of independent claims 1, 32, and 35-37, and of dependent claims 2-31 and 33-34, and allowance of new claims 38-44.

Respectfully submitted,

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